

Application No. 09/095,323

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

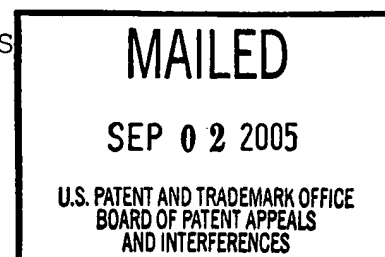
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. LAUFER

Application No. 09/095,323

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



This application was electronically received at the Board of Patent Appeals and Interferences on June 21, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

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Appellant filed Information Disclosure Statements (IDS's) on September 9, 1998 and on February 18, 1999. It is not clear from the record whether or not these IDS's have been considered or acknowledged. The examiner needs to consider the IDS's and acknowledge such consideration.

The Final Rejection, mailed July 19, 2001, rejects Claims 29, 30, 34, 35, 39, 40 and 45 under 35 USC 112, second paragraph, Claim 51 under 35 USC 102(b) as being clearly anticipated by Clarke; and Claims 28-47 and 50 under 35 USC 103(a) as being unpatentable over Clark.

The Appeal Brief filed January 25, 2002 withdraws Claims 1-27 and 48-49 and cancels Claims 38-47 and 51. The rejection to Claims 28-37 and 50 under 35 USC 103(a) as being unpatentable over Clark were appealed.

The Examiner's Answer dated September 6, 2002, rejects claims 28-37 and 50 under 35 USC 103(a) as being unpatentable over Clark in combination with Waksman (WO97/37715). It should be noted that the Waksman reference was not previously cited as prior art or previously used to reject the claims. This reference would constitute the introduction of a new ground of rejection. See MPEP 1208.01.

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Section 1208.01 of the Manual of Patent Examining Procedure (MPEP) (8th ed., Aug. 2001) states:

37 CFR § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Accordingly, it is

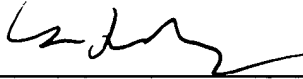
ORDERED that the application is returned to the examiner for resolution of the following issues:

- 1) consideration and proper written response to the Information Disclosure Statements dated September 9, 1998 and February 18, 1999;
- 2) revise the Examiner's Answer, to exclude the Waksman (W097/37715) reference, or
- 3) reopen prosecution to include the Waksman (W097/37715) reference and the new ground of rejection (including providing a copy of the reference); and
- 4) any further action as deemed appropriate

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e. abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES



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